IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Board of Patent Appeals and Interferences

In re Patent Application of

STERCHI et al.   Atty. Ref.: JSP-723-1259

Serial No. 10/078,526   TC/A.U.: 2628

Filed: February 21, 2002   Examiner: P. Pappas

For: SYSTEM AND METHOD FOR CONTROLLING ANIMATION BY
TAGGING OBJECTS WITHIN A GAME ENVIRONMENT

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January 22, 2008 (= Tuesday)
(January 21, 2008 = Federal Holiday)

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Sir:

REPLY BRIEF

Applicant hereby submits this Reply Brief under the provisions of 37 C.F.R. § 1.193(b) in response to the Examiner's Answer mailed November 21, 2007.

The arguments set forth in the Appeal Brief dated August 20, 2007 are incorporated herein by reference, and Applicant will not repeat the same herein. The following arguments are presented in response to new arguments presented in the Examiner's Answer and to further clarify Applicant's previous positions.

Applicant notes with appreciation that the rejection of all claims 1-16 under 35 U.S.C. § 101 has been withdrawn.

With respect to the outstanding rejection of all claims 1-16 as allegedly being "obvious" over Ventrella et al. (U.S. Patent No. 6,545,682) in view of Bickmore (U.S. Publication No. 2003/0206170) under 35 U.S.C. § 103(a), Applicant offers the following observations.

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First, the Examiner has not identified any teachings or suggestions in the prior art for the limitation of "when the user-controlled character is within a predetermined proximity to the tag, using the location of the tag and the tag information to dynamically modify the user-controlled character's animation and the animation of the [tagged] object," as required by claim 1. Page 11 of the Examiner's Answer admits that Ventrella does not disclose this limitation of claim 1. The Examiner's Answer does not identify where in Bickmore such a teaching or suggestion might be found, and it provides no reasoning why this limitation would be obvious as in the alleged combination of Ventrella and Bickmore. Yet page 12 of the Examiner's Answer still indicates that somehow the combination of references:

> "is considered to result in a system which would allow for said bird [the alleged tagged object] to in fact have values (tag information) associated with it so that when said avatar turns to stare at said bird in flight said bird might adjust its flight depending on the type of tag information associated with said bird (e.g., fear of detection, which might incline the bird to adjust its course and fly in a direction away from said avatar when detected by said avatar)."

Applicant notes that the foregoing "example" is wholly fabricated from one specific example provided in Ventrella (at col. 18, lines 13-34) that clearly and unequivocally stops well short of this scenario, and which relates solely to the "alertness" trait of the avatar and not to any trait or action of the tagged object itself. As the Supreme Court warned in *KSR v. Teleflex*, "[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of argument reliant upon ex post reasoning." The Examiner's "example" employs exactly this sort of ex post reasoning.

Moreover, Applicant respectfully submits that the Examiner's "example" makes no sense in the context of Ventrella, which clearly is directed to influencing the behavior of the avatar -- and the avatar alone -- through the modification of the "genes" of the avatar. It makes no sense in the context of Bickmore, which clearly is directed to user navigation through HTML

documents. Finally, it makes no sense in the context of the alleged combination of Ventrella and Bickmore, which -- even if appropriate -- would suggest leading the user through one or more locations via an avatar programmed to react to stimuli in ways dictated by the genes of the avatar. This is in sharp contrast to the instant invention, which in certain exemplary embodiments enables the user to move an avatar through a three-dimensional virtual world (rather than the avatar moving the user) and to cause <u>both</u> the avatar and the tagged object to react to instructions embedded in the tagged object itself (independent of the "personality" of the avatar). It thus is clear that the invention of claim 1 and the alleged combination could not be more different.

Claims 7 and 12 incorporate similar limitations to claim 1 and substantially the same reasoning applies thereto.

As such, Applicant respectfully submits that there is no reasonable basis for concluding that the above-noted and similar limitations are taught or suggested by Ventrella or Bickmore, alone or in combination. Accordingly, Applicant respectfully requests that the rejection of claims 1-16 under 35 U.S.C. § 103 be reversed.

<u>Second</u>, switching from one static HTML page to another is not the "animation" required by the claims. It is true that claims are to be given their broadest reasonable interpretation during examination. *See In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369 (Fed. Cir. 2004); MPEP § 2111.01(I). It is also true that claim terms ordinarily are to be given their plain meaning. And, "the ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc). However, the Examiner's contention that "<u>one</u>

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form of animation . . . [involves] the display of a plurality of frames in a sequence and wherein said frames share some commonality" (emphasis in original) is unreasonable. Nor would such an interpretation be in accordance with the ordinary and customary meaning of such a claim term assigned by a person of ordinary skill in the art at the time of the invention.

From the outset, it is noted that claim 1 relates to "[a] method of animating a user-controlled character *in a three-dimensional environment of a dynamic three-dimensional game space*," the method of claim 7 relates to "[a] method for controlling the animation of a user-controlled character *in a three-dimensional world of a dynamic three-dimensional game space*," and claim 12 relates to "[a] method of animating an object *in a virtual three-dimensional world of a dynamic three-dimensional game space*." Figures 1-9 of the instant application visually demonstrate certain exemplary embodiments of the claimed invention. Paragraph 2 of the specification of the instant application reveals that the exemplary embodiments provide "a reactive animation system that enables characters or other graphical characters to appear much more realistic as they interact with a virtual world in which they are displayed." The Background and Summary section of the instant application notes that "graphic system designers have confronted [the problem of] how to efficiently model and render realistic looking animations in real time or close to real time" (see paragraph 6) and, in paragraph 7, the specification notes that the approaches taken by the claimed invention may cause a character to have "much more human-like reactions to its environment while moving through the virtual world, and the character can be made to appear as if it has 'come to life.'" Elsewhere, the Detailed Description identifies illustrative techniques for creating realistic animations, including, for example, using key frames, inbetweening, and inverse kinematics.

Despite the plain language of the claims and the context provided by the specification and figures of the instant application, the Examiner's Answer essentially contends that a slideshow is equivalent to the claimed animation. This simply is not so. That is, the Examiner's Answer incorporates unreasonable interpretations of the terms "animation" and "animating," as such terms would be understood to be something quite different from a slideshow by one skilled in the art at the time of the invention. The Examiner's Answer also ignores the contextualization of the claimed invention provided by the respective preambles -- which breathe life and meaning into the limitations of claimed invention, especially given the erroneous interpretations of the above-noted terms. *See Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999); MPEP § 2111.02; *cf. Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329, 1333 (Fed. Cir. 2003) (finding an "in need" human to be essential when treating or preventing pernicious anemia, just as a "dynamic three-dimensional game space" is necessary when animating the characters of the claimed invention in the instant application).

The Examiner's Answer also asks whether one would consider a series of frames changing only in terms of color to be "animation." Applicant respectfully submits that one of ordinary skill in the art at the time of the invention would answer this rhetorical question with a clear and unambiguous "No."

Based on the above "reasoning," the Examiner concludes that "opening a plurality of webpages, one after another (i.e. each replacing the other), wherein said webpages share some commonality (e.g., a common origin such as a link embedded on a specific page)" discloses "one form of animation." As shown above, such a slideshow does not correspond to any kind of animation -- much less the kind of animation contemplated in the claims or the type of animation that would have been understood by one of ordinary skill in the art at the time of the invention.

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As such, Applicant respectfully submits that the interpretations of the claimed "animation" and "animating" are erroneous. Thus, there is no reasonable basis for concluding that the alleged combination of Ventrella or Bickmore disclose the claimed "animation" and "animating," at least as such terms would have been understood by one of ordinary skill in the art at the time of the invention. Accordingly, Applicant respectfully requests that the rejection of claims 1-16 under 35 U.S.C. § 103 be reversed.

Third, Applicant again observes that if Ventrella and Bickmore were forcibly combined, a user-controlled character coming into proximity to a tagged object would cause an animation of the user-controlled character and an animation of the underlying virtual environment. As such, the alleged combination would not result in an animation of a tagged object, as required by claim 1. Similar limitations are required by claims 7 and 12. The situations posited on page 13 of the Examiner's Answer are inapposite. For example, arguing that "merely a portion of the virtual environment is animated (e.g., an avatar)" misses the point -- what is being disputed is whether animation of the tagged object (i.e., a hyperlink) is taught or suggested: It is not. Similarly, the argument that multiple avatars may be activated and perform a specific behavior also misses the point -- these other avatars are not tagged objects at all; thus, it does not matter whether they are activated and/or animated. Finally, it is unimportant whether the reader moves a first avatar to a docked position before a second avatar moves to a link -- nothing whatsoever happens to the link and thus nothing whatsoever happens to the tagged object.

As such, Applicant respectfully submits that even if Ventrella and Bickmore were forcibly combined, a user-controlled character coming into proximity to a tagged object would cause an animation of the user-controlled character and an animation of the underlying virtual environment -- not an animation of the user-controlled character and the tagged object.

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Accordingly, Applicant respectfully requests that the rejection of claims 1-16 under 35 U.S.C. § 103 be reversed.

Fourth, Applicant notes that there is no support in any of the prior art of record for the assertion that "any animation performed in 2D can be performed equally in 3D." To the contrary, the specification of the instant application describes some of the problems associated with prior attempts at developing high-quality, realistic animations of objects within a three-dimensional virtual environment. There simply is nothing of record to support the statement that "any animation performed in 2D can be performed equally in 3D," nor is there anything of record to support that analogous problems ever even existed in the 2D world -- much less the static world of HTML documents. In marked contrast, certain exemplary embodiments of the claimed invention advantageously facilitate the creation of such animations without having to handcraft the animation for every possible scene in advance. Thus, it is possible to enable animation to be generated on-the-fly an in an unpredictable and realistic manner. As a result, the character's animation can constantly change in a variety of ways and depending on many possible variables.

Even if were true that "any animation performed in 2D can be performed equally in 3D," Applicant respectfully submits that one of ordinary skill in the art would not look to an HTML navigation system when designing a solution for animating a three-dimensional virtual world. Applicant is not attacking the references individually where the rejection is based on a combination of references, which would be improper under *In re Keller*, 642 F.2d 413 (CCPA 1981). Rather, as has been well covered in the Appeal Brief, Applicant merely is arguing against the combination of references by observing the fundamental differences of the subject matter, the different problems addressed by the respective references, and the level of skill in the art at the

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time of the invention. *Cf. Keller*, 642 F.2d at 425 ("[T]he test is what the combined teachings of those references would have suggested to those of ordinary skill in the art."). Simply put, a skilled game designer or a skilled graphic animator at the time of this invention would not look to a feature of an HTML document when trying to reduce the level of difficulty associated with animating characters moving about in a three-dimensional virtual world. Even if one of ordinary skill in the art did look across such diverging fields and teachings, one still would not be led to the claimed invention.

"The fact that the dimension will vary by one degree does not render said combination inoperable," even if true, is not relevant to the determination of obviousness in this case. Indeed, Applicant has not argued that the alleged combination would be inoperable. Rather, Applicant has argued that one of ordinary skill in the art at the time of the invention would not have combined Ventrella and Bickmore. Applicant also has argued that the forced combination of Ventrella and Bickmore would not result in the claimed invention. Finally, Applicant has argued that a combination of Ventrella and Bickmore would require a change to the underlying principles of the prior art, contrary to the strictures of MPEP § 2143.01.

In sum, there is no support for the assertion that "any animation performed in 2D can be performed equally in 3D" and, even if true, the "the fact that the dimension will vary by one degree does not render said combination inoperable" is unimportant to a showing of obviousness in the instant application. What is important is the positive teachings of Ventrella and Bickmore and the knowledge of one skilled in the art at the time of the invention. In view thereof, Applicant respectfully submits that there is no suggestion to combine the teachings of Ventrella and Bickmore, as advanced by the Examiner, except from using Applicant's invention as a template through a hindsight reconstruction of Applicant's claims. *Cf. Ex Parte Crawford et al.*,

Appeal 20062429, decided May 30, 2007. Accordingly, Applicant respectfully requests that the rejection of claims 1-16 under 35 U.S.C. § 103 be reversed.
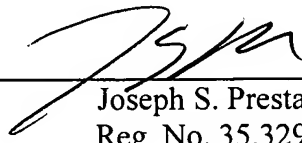
CONCLUSION

For at least the reasons set forth above and discussed in detail in the previously filed Appeal Brief, it is respectfully requested that the rejections on Appeal be reversed.

Respectfully submitted,

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